

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant:	Brian N. Tufte	Confirmation No.:	2577
Serial No.	10/027,829	Examiner:	Igor N. Borissov
Filing Date:	October 19, 2001	Group Art Unit	3639
For:	METHOD AND SYSTEM FOR INCREASING THE PARTICIPATION OF CONTRIBUTORS TO A CHARITY OR OTHER NON-PROFIT		
Docket:	1076.1103101		

REPLY BRIEF UNDER 37 C.F.R. § 41.41

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I hereby certify that this paper is being electronically transmitted to the United States Patent and Trademark Office on the date shown below.


Lynn Thompson

April 22, 2008

Date

Pursuant to 37 C.F.R. §41.41, Appellant hereby submits this Reply Brief in response to the Examiner's Answer mailed February 22, 2008.

REMARKS

On pages 3-13 of the Examiner's Answer, the Examiner merely repeats the rejections set forth in the Final Office Action dated July 24, 2007. On pages 14-18, the Examiner sets forth a number of rebuttal remarks related to Sections VII (A)-(F) of Appellant's Appeal Brief. None of these remarks overcome Appellant's position set forth in Appellant's Appeal Brief. For completeness, however, Appellant has elected to provide brief rebuttal comments in response to some of the Examiner's remarks related to Section VII (A).

On page 14 of the Examiner Answer, and under the heading (10-01), the Examiner states:

The point is that the specification does not provide any indication what particular financial mechanism except cash is used for the invention. A method of paying by electronic wire transfer would require different method steps and would require different type of apparatus than that one for paying by money order, and paying by cash would not require either method steps at all. Therefore, without providing the support in the specification for conducting payment by "cash equivalent", the Examiner considers that the specification does not contain full, clear, concise, and exact terms as to enable any person skilled in the art to make and use the invention (emphasis added).

It appears that the Examiner has now changed the rejection of claim 10 under 35 U.S.C. § 112, first paragraph, from a written description rejection to an enablement rejection. Appellant understands that the enablement requirement of 35 U.S.C. 112, first paragraph, is separate and distinct from the written description requirement. *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 USPQ2d 1111, 1116-17 (Fed. Cir. 1991). Section VII(A) of Appellant's Appeal brief makes clear that claim 10 fully satisfies the written description requirement of 35 U.S.C. § 112, first paragraph, and the Examiner's Answer does not rebutted Appellant's position.

The Examiner's newly raised rejection of claim 10 under the enablement requirement of

35 U.S.C. § 112, first paragraph, is also without merit. As noted in MPEP 2164.01, the “[t]he test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation.” United States v. Teletronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988). Also, a patent need not teach, and preferably omits, what is well known in the art. In re Buchner, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991); Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986), cert. denied, 480 U.S. 947 (1987); and Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co., 730 F.

One reasonably skilled in the art, after reading the present specification and coupled with information known in the art, could easily have delivered a delivery lot that includes a cash equivalent, without undue experimentation. The Examiner states “[t]he point is that the specification does not provide any indication what particular financial mechanism except cash is used for the invention”. This is factually incorrect. Although not using the exact phrase “cash equivalent”, the specification does identify a number of alternatives to cash, including checks and credit card transfers (see, for example, specification, page 7, lines 6-13). One skilled in the art would clearly understand these and other similar financial mechanisms to be “cash equivalents”.

The Examiner also asserts “[a] method of paying by electronic wire transfer would require different method steps and would require different type of apparatus than that one for paying by money order, and paying by cash would not require either method steps at all.”

Apparently, this is an attempt to argue that undue experimentation would be required by one reasonably skilled in the art in order to deliver a delivery lot that includes a cash equivalent. . That is, according to the Examiner, one skilled in the art would readily know how to deliver a delivery lot of cash, but would be unable to figure out how to deliver a delivery lot that includes a cash equivalent without undue experimentation. This, despite the well known nature of cash equivalents in the art and the specific alternative cash equivalents disclosed in the present specification. This flies in the face of logic, and is clearly unreasonable. As such, the rejection under 35 U.S.C. § 112, first paragraph, should be reversed.

Beginning on page 14 of the Examiner Answer, and under the heading (10-02), the Examiner states:

As can be seen from this paragraph, *donations are accumulated in the database until the resource request is met*. The Examiner understands this as, if there is a specific request for a thousand dollars (for example) for a particular project registered within the system, the incoming donations are counted until the resource request is met (until said thousand dollars are accumulated). If the resource request is not received, and an amount is not known, how does one know at what point in time or upon reaching which amount the accumulation of funds in the database has to be terminated? Furthermore, the recited portion of the specification explicitly describes a situation when received donations may exceed the resource request, or required/known amount. As per underlined by Applicant last sentence of the paragraph, this text describes merely certain technicality of fails management in the database and does not affect the concept in question. Therefore, the Examiner maintains that the specification does not support” “wherein *the two or more donations are not initially designated as corresponding to any particular delivery lot*”, and that Claim Rejection under 35 U.S.C. 112, first paragraph, is proper (emphasis in original).

Appellant does not understand these remarks. The present specification clearly describes embodiments where two or more donations are not initially designated as corresponding to any particular delivery lot. For example, the specification states:

Once the donation is received, the organization may assign the donation to a delivery lot of cash, goods and/or services. This may be accomplished by, for example, making a resource request to the database. The database may accumulate donations until the resource request is met. The donations may be accumulated using an algorithm such as First-In-First-Out (FIFO), Last-In-Last-Out (LIFO), or any other suitable algorithm or method. In some cases, donations totaling more than the resource request may be assigned to a delivery lot to compensate for the overhead of the organization. The donations that have been accumulated to meet the resource request may then be updated to include a pointer or other reference to the assigned delivery lot (emphasis added).

(Specification, page 3, lines 5-13). As can be seen from this passage, since the organization assigns a donation to a delivery lot after it is received, the donation was not initially assigned to any particular delivery lot (see also, for example: page 9, lines 2-19; page 11, lines 15-17; page 13, line 23 through page 14, line 11; reference numeral 100 of Figure 4, where donation ID "N3389232" has not yet been assigned to a delivery lot; step 148 of Figure 7, which assigns a delivery lot number to those donations (plural) that have been accumulated to meet the resource request; and step 168 which assigns a delivery lot number to those donations (plural) that have been accumulated to meet the resource request). Clearly, the present specification reasonably conveys to one skilled in the relevant art that the inventor, at the time the application was filed, had possession of "receiving either directly or indirectly two or more donations from two or more contributors, wherein the two or more donations are not initially designated as corresponding to any particular delivery lot". For these and other reasons, the rejection of claims 20-23 under 35 U.S.C. § 112, first paragraph, is clearly in error, and should be reversed.

On page 16 of the Examiner Answer, and under the heading (10-03), the Examiner states:

(10-03) Applicant argues that Smith et al. does not teach "providing the location information to the contributor". Also, Applicant argues that sender in Smith et al. equates to the Projects for Hope organization, rather than the

contributor.

In response to this argument, the Examiner points out that Smith et al. discloses providing the location information of the mailed item to the sender via a personal Web page [0009]; [0018]. Furthermore, Smith et al. teaches [0009]:

Thus, to keep track of the changes to the delivery status, the user has only to check his or her web page rather than inquire at the various companies or the postal service and/or sort through e-mail messages from them" (emphasis added).

and [0018]:

The table further includes an attachment field in which messages from the sender, postal service or other delivery company may be linked to the mail piece delivery status information.

Smith et al. explicitly differentiates between the sender (contributor in the instant invention), and a shipping service provider (the charitable organization). Clearly, the "sender" here equates to the contributor in Project for Hope, not the Project for Hope organization. And a shipping service provider in Smith et al. corresponds to the charitable organization in the instant invention.

For some reason, the Examiner continues to assert that the "sender" in Smith et al. somehow equates to the contributor of, for example, claim 1. Both paragraphs [0009] and [0018] make clear that Smith et al. relates to a system for tracking mail pieces that are sent by or to a user. Clearly, the "sender" in Smith et al. is the user that actually sends the mail pieces (i.e. package, envelope, or other mail pieces) to an intended recipient.

The Examiner continues to ignore the fact that the "contributors" to the Project for Hope Web-site do not "send" anything to the ultimate destination (e.g. Mexico). Instead, the contributors merely provide a donation to a designated project via the Project for Hope web-site. It is clear that the Projects for Hope organization itself actually packages and sends the goods to

the ultimate destination. In fact, the contributors to the Project for Hope Web-site would not even know where their donation will ultimately be delivered, and certainly would not know the address of the destination, which would be required for the contributors to be considered “senders”. How can the contributors to the Project for Hope Web-site be considered equivalent to the “senders” in Smith et al., when the contributors do not even know the address of the ultimate destination? The entire purpose of the Project for Hope organization appears to be to collect donations from contributors, and then use those donations to purchase and send goods to people in need. It is abundantly clear that neither the Projects for Hope reference, the Smith et al. reference, nor a combination thereof, teaches, discloses or suggests the steps of: obtaining the location of the delivery lot at one or more points in time; and providing the location of the delivery lot to the contributor at one or more points in time, particularly in combination with the other elements of claim 1. For these and other reasons, the Examiner rejections of claims 1-30 and 32 under 35 U.S.C. § 103 are clearly erroneous and should be reversed.

The Examiner’s remarks beginning on pages 17 of the Examiner Answer, and under the headings (10-04)–(10-07), do not appear to raise any new substantive arguments, but merely repeat the rejections in the Final Office Action. As such, further remarks beyond those set forth in Appellant’s Appeal Brief are not believed to be necessary.

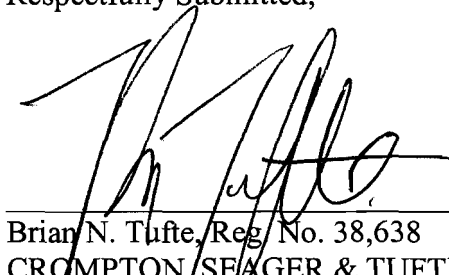
Conclusion

For the reasons set forth in Appellant’s Appeal Brief, as well as the reasons set forth in this Reply Brief, the rejection of claims 1-30 and 32 under 35 U.S.C. § 112 and 35 U.S.C. § 103 should be reversed.

Application Serial No. 10/027,829

Respectfully Submitted,

Date: April 22, 2008

A handwritten signature in black ink, appearing to read 'Brian N. Tufte', written over a horizontal line.

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